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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,170	09/19/2003	Claude D. Gourand		7111

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CLAUDE D. GOURAND
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EXAMINER

HOGE, GARY CHAPMAN

ART UNIT	PAPER NUMBER
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3611

DATE MAILED: 07/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/666,170	Applicant(s) GOURAND ET AL.	
	Examiner Gary C. Hoge	Art Unit 3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8,9,11,15-23 and 31-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8,9,11,15-23 and 31-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the pocket being integrally formed as part of the wallpaper substrate (claim 20) and the wallpaper formed to allow designs on adjacent rows or columns thereof to align and be in agreement (claim 35) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 20 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The recitation that the pocket is integrally formed as part of the wallpaper substrate, etc., is new matter.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is no antecedent basis for "said second adhesive layer."

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

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evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 9, 11, 15-17, 21, 23 and 32-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lytle (6,052,933) in view of “Wallpaper Wishes”.

Regarding claims 15 and 34, Lytle discloses a pocket **10** having a transparent front layer **18** and at least one opening (at the top edge) and displaying at least one object **12**, the pocket coupled to a wall via a first adhesive layer **46**. The pocket is disclosed as being mounted to a dining room wall (col. 4, lines 46-53). However, it is not known whether the wall includes wallpaper. “Wallpaper Wishes” teaches that it was known in the art to decorate a dining room with wallpaper. It would have been obvious to one having ordinary skill in the art at the time the invention was made to decorate the dining room wall disclosed by Lytle with wallpaper, as taught by “Wallpaper Wishes,” in order to improve the aesthetic appearance of the dining room.

Regarding claims 9 and 23, “Wallpaper Wishes” clearly shows a leaf-like pictorial design on the wallpaper.

Regarding claims 11 and 34, although Lytle only discloses using a single frame, it is well known to attach a plurality of similar frames to a wall, in order to display a plurality of pictures, and it would have been obvious to use a plurality of the frames disclosed by Lytle for that reason. Besides, it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claim 17, the pocket disclosed by Lytle includes a rear layer **24**.

Regarding claims 32 and 34, the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation does not distinguish over the prior art.

Regarding claims 33 and 36, it is a property of all wallpaper that it can be cut to a desired length.

Regarding claim 35, the wallpaper disclosed by "Wallpaper Wishes" is in a repeating pattern, as is conventional with wallpaper.

9. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lytle (6,052,933) in view of "Wallpaper Wishes" as applied to claim 15, above, and further in view of Polzin (5,025,581).

Lytle, as modified by "Wallpaper Wishes," discloses the invention substantially as claimed, as set forth above. However there is a backing layer between the front layer and the wallpaper. Polzin teaches that it was known in the art to simplify the mounting of a pocket to a surface by omitting the backing layer (col. 6, lines 34-41). It would have been obvious to one having ordinary skill in the art at the time the invention was made to omit the backing layer disclosed by Lytle, as taught by Polzin, in order to simplify the mounting of the pocket to the surface.

10. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lytle (6,052,933) in view of "Wallpaper Wishes" as applied to claim 15, above, and further in view of Bowman (4,771,557).

Lytle, as modified by "Wallpaper Wishes," discloses the invention substantially as claimed, as set forth above. However, the adhesive that attaches the pocket disclosed by Lytle to

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the wall is removable. Bowman teaches that it was known in the art to attach a pocket to a surface using a permanent adhesive. It would have been obvious to one having ordinary skill in the art at the time the invention was made to attach the pocket disclosed by Lytle to a wall using a permanent adhesive, as taught by Bowman, in order to hold the pocket more securely to the wall.

11. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lytle (6,052,933) in view of “Wallpaper Wishes” as applied to claim 15, above, and further in view of Fagan (4,783,354).

Lytle, as modified by “Wallpaper Wishes,” discloses the invention substantially as claimed, as set forth above. However, it is not known whether the wallpaper disclosed by “Wallpaper Wishes” is non-permanently mounted to the wall. Fagan teaches that it was known in the art to attach wallpaper to a wall using a non-permanent adhesive. It would have been obvious to one having ordinary skill in the art at the time the invention was made to mount the wallpaper disclosed by “Wallpaper Wishes” to a wall using non-permanent adhesive, as taught by Fagan, in order to be able to remove the wallpaper without damaging the wall.

12. Claims 9, 11, 15-17, 21, 23 and 31-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lytle (6,052,933) in view of “DecorateThis.com”.

Regarding claims 15 and 34, Lytle discloses a pocket 10 having a transparent front layer 18 and at least one opening (at the top edge) and displaying at least one object 12, the pocket coupled to a wall via a first adhesive layer 46. The pocket is disclosed as being mounted to a dining room wall (col. 4, lines 46-53). However, it is not known whether the wall includes wallpaper. “DecorateThis.com” teaches that it was known in the art to decorate a dining room

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with wallpaper. It would have been obvious to one having ordinary skill in the art at the time the invention was made to decorate the dining room wall disclosed by Lytle with wallpaper, as taught by “DecorateThis,” in order to improve the aesthetic appearance of the dining room.

Regarding claims 9 and 23, “DecorateThis.com” clearly shows a pictorial design on the wallpaper. (See “Enlargement”).

Regarding claims 11 and 34, although Lytle only discloses using a single frame, it is well known to attach a plurality of similar frames to a wall, in order to display a plurality of pictures, and it would have been obvious to use a plurality of the frames disclosed by Lytle for that reason. Besides, it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claim 17, the pocket disclosed by Lytle includes a rear layer 24.

Regarding claims 31 and 37, “DecorateThis.com” teaches that the wallpaper applied to the dining room wall can be in the form of a border.

Regarding claims 32, 34 and 38, the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation does not distinguish over the prior art.

Regarding claims 33 and 36, it is a property of all wallpaper that it can be cut to a desired length.

Regarding claim 35, the wallpaper disclosed by “DecorateThis.com” is in a repeating pattern, as is conventional with wallpaper.

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13. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lytle (6,052,933) in view of "DecorateThis.com" as applied to claim 15, above, and further in view of Polzin (5,025,581).

Lytle, as modified by "DecorateThis.com," discloses the invention substantially as claimed, as set forth above. However there is a backing layer between the front layer and the wallpaper. Polzin teaches that it was known in the art to simplify the mounting of a pocket to a surface by omitting the backing layer (col. 6, lines 34-41). It would have been obvious to one having ordinary skill in the art at the time the invention was made to omit the backing layer disclosed by Lytle, as taught by Polzin, in order to simplify the mounting of the pocket to the surface.

14. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lytle (6,052,933) in view of "DecorateThis.com" as applied to claim 15, above, and further in view of Bowman (4,771,557).

Lytle, as modified by "DecorateThis.com," discloses the invention substantially as claimed, as set forth above. However, the adhesive that attaches the pocket disclosed by Lytle to the wall is removable. Bowman teaches that it was known in the art to attach a pocket to a surface using a permanent adhesive. It would have been obvious to one having ordinary skill in the art at the time the invention was made to attach the pocket disclosed by Lytle to a wall using a permanent adhesive, as taught by Bowman, in order to hold the pocket more securely to the wall.

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15. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lytle (6,052,933) in view of "DecorateThis.com" as applied to claim 15, above, and further in view of Fagan (4,783,354).

Lytle, as modified by "DecorateThis.com," discloses the invention substantially as claimed, as set forth above. However, it is not known whether the wallpaper disclosed by "DecorateThis.com" is non-permanently mounted to the wall. Fagan teaches that it was known in the art to attach wallpaper to a wall using a non-permanent adhesive. It would have been obvious to one having ordinary skill in the art at the time the invention was made to mount the wallpaper disclosed by "DecorateThis.com" to a wall using non-permanent adhesive, as taught by Fagan, in order to be able to remove the wallpaper without damaging the wall.

Response to Arguments

16. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary C. Hoge whose telephone number is (571) 272-6645. The examiner can normally be reached on 5-4-9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Gary C Hoge
Primary Examiner
Art Unit 3611

gch